

paging service subscribers, small business paging service subscribers, and large business paging service subscribers.

21. (New) The method of Claim 5, wherein the step of generating the identification number associated with at least one paging service subscriber comprises generating a plurality of capcodes associated with at least one paging service subscriber.

22. (New) The method of Claim 21, wherein the step of generating the plurality of capcodes comprises generating the plurality of capcodes corresponding to at least one of a number of advertisement scripts to be attached and a number of times a day the subscriber receives an advertisement script.

REMARKS

Favorable reconsideration of the present application in light of the above amendment and in light of the following discussion is respectfully requested.

Claims 1-22 are presently active in this case, with claims 8-12 withdrawn from consideration as being directed to a non-elected invention, with claims 1-7 amended and with claims 13-22 added, by way of the present amendment, without the introduction of new matter (see, e.g., claims 1-7 as originally filed; page 7, lines 13-30; and page 8, lines 7-22 of Applicants' disclosure).

In the present Office Action, (i) claims 1, 2, 4, 5 and 7 were rejected under 35 U.S.C. § 102(e) as being anticipated by *Taubenheim et al* (US 6,060,997); and (ii) claims 3 and 6 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Taubenheim et al* in view of *DeLuca et al* (US 5,870,030)

Independent claims 1 and 5 and claims dependent therefrom, as amended, are patentably distinguishable over *Taubenheim et al.* and *DeLuca et al.*, taken alone or in combination. Amended independent claim 1 recites “generating an identification number associated with at least one paging service subscriber.” In contrast, *Taubenheim et al.* fails to disclose **generating an identification number** associated with at least one paging service subscriber. As noted at column 2, lines 34-41 of *Taubenheim et al.* “the processor 109... determines ... an address to encode with the information service.” However, **determining** an address as disclosed by *Taubenheim et al.* cannot reasonably be equated to “**generating** an identification number associated with at least one paging service subscriber.” The *Taubenheim et al.* design utilizes a paging unit’s existing address for effectuating advertisement delivery, without the need to generate any identification number. As described at page 8, lines 7-22 of Applicants’ disclosure, an identification number, such as a capcode, is generated and programmed into a paging unit and the programmed capcode(s) is used to send advertisements to the paging unit, thereby advantageously permitting targeting of subscribers.

The noted deficiencies in *Taubenheim et al.* are further evident with respect to dependent claim 2, which recites “storing the generated identification number in a central database” and which also is not disclosed by *Taubenheim et al.* The present Office Action attempts to cure such deficiency in *Taubenheim et al.* by asserting that such feature is inherent in a paging system and citing column 5, lines 25-48 of *Taubenheim et al.*

However, to establish inherency, it must be clear that the missing descriptive matter is necessarily present in the reference. *In re Roberston*, 49 USPQ2d at 1951. Under the principles of inherency, the prior art must necessarily function in accordance with, or include, the claim limitations. *MEHL/Biophile Int’l.*, No. 99-1038 at § II, 4. Since *Taubenheim et al.* discloses

using an existing address of paging unit, generating an identification number is not necessary and therefore “storing the [generated] identification number in a central database” cannot be inherent. With respect to column 5, lines 25-48 of *Taubenheim et al.*, this disclosure is directed to the paging unit 130 and is not directed to “storing the generated identification number in a central database.”

The *DeLuca et al.* reference is directed to a system 20 for permitting a user of a selective call receiver 31 to receive a certain number of personal messages and information service updates without paying a fee for such services in return for reading advertisements wirelessly transmitted to the selective call receiver. See Abstract and Figure 5 of *DeLuca et al.* Accordingly, *DeLuca et al.* fails to cure the noted deficiencies in of *Taubenheim et al.*

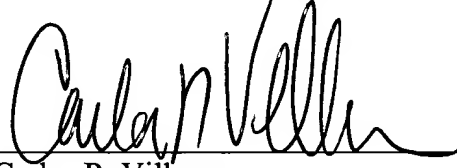
Amended independent claim 5 now recites “generating an identification number associated with at least one paging service subscriber and storing the generated identification number in a central database; programming a paging unit of the paging service subscriber with the identification number...” These limitations and features are not satisfied by the applied references, taken alone or in combination, for substantially the same reasons as discussed above.

In addition, new claims 13-22 have been added, which recite further features of the invention recited in independent claims 1 and 5 and which also are not disclosed nor suggested by *Taubenheim et al.* and *DeLuca et al.*, taken alone or in combination. No new matter is introduced. See, e.g., claims 1-7 as originally filed; page 7, lines 13-30; and page 8, lines 7-22 of Applicants’ disclosure.

Consequently, in view of the present amendment, no further issues are outstanding in the present application and the present application is in condition for formal allowance. An early and favorable action is therefore respectfully requested. If, however, any unresolved issues remain, it is respectfully requested that the Examiner contact the undersigned attorney so that such issues may be resolved as expeditiously as possible.

Respectfully Submitted,

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A handwritten signature in black ink, appearing to read 'Carlos R. Villamar', written over a horizontal line.

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APPENDIX

Please amend claims 1-7 and add new claims 13-22, as follows.

--1. (Amended) A method for targeted marketing, comprising:

generating [unique] an identification [numbers] number [for predetermined] associated
with at least one paging service [subscribers] subscriber; and

[creating advertisement scripts; and]

[appending] attaching an advertisement [scripts] script to a page [messages] message for
the paging service [subscribers] subscriber having the [unique] identification [numbers] number.

2. (Amended) The method [for targeted marketing according to] of Claim 1, further
comprising:

storing the [unique] generated identification [numbers] number in a central database;

programming a paging [units] unit of the paging service [subscribers] subscriber with the
[unique] identification [numbers] number;

correlating the [unique] identification [numbers] number stored in the central database
with the [unique] identification [numbers] number programmed into the paging [units] unit; and

transmitting the [advertisements scripts] advertisement script and [messages] the message
to the paging [units] unit programmed with the [unique] identification [numbers] number based
upon the correlation.

3. (Amended) The method [for targeted marketing according to] of Claim 2, wherein the
step of [appending] attaching the advertisement [scripts] script to the page [messages] message
comprises transmitting the advertisement script prior to transmitting the message.

4. (Amended) The method [for targeted marketing according to] of Claim 2, wherein the step of [appending] attaching the advertisement [scripts] script to the page [messages] message comprises transmitting the advertisement script after transmitting the message.

5. (Amended) A method for [appending] attaching advertisements to messages received by paging units, comprising:

generating [unique] an identification [numbers] number [for predetermined] associated with at least one paging service [subscribers] subscriber and storing the [numbers] generated identification number in a central database;

programming [the] a paging [units] unit of the paging service [subscribers] subscriber with the [unique] identification [numbers] number;

[creating advertisement scripts;]

[appending] attaching an advertisement [scripts] script to a page [messages] message for the paging service [subscribers] subscriber having the [unique] identification [numbers] number programmed into [their] the paging [units] unit; and

transmitting the [advertisements scripts] advertisement script and [messages] the message to the paging [units] unit having the [unique] identification [numbers] number.

6. (Amended) The method [for appending advertisements to messages received by paging units according to] of Claim 5, wherein the step of [appending] attaching the advertisement [scripts] script to the page [messages] message comprises transmitting the advertisement script prior to transmitting the message.

7. (Amended) The method [for appending advertisements to messages received by paging units according to] of Claim 5, wherein the step of [appending] attaching the

advertisement [scripts] script to the page [messages] message comprises transmitting the advertisement script after transmitting the message.

13-22. (New)--.